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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,269	11/06/2000	L. Charles Hardy	53415USA8C.038	9169

32692 7590 11/25/2003

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EXAMINER

EVERHART, CARIDAD

ART UNIT	PAPER NUMBER
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2825

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/707,269

Applicant(s)

KAISAKI ET AL.

Examiner

Caridad M. Everhart

Art Unit

2825

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 16-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- ☐ Interview Summary (PTO-413) Paper No(s). ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Response to Arguments

Applicant's arguments filed 9-2-03 have been fully considered but they are not persuasive. Applicant has argued that there would be no motivation to use the additives disclosed by Kaufmann in the absence of particulates, because Kaufmann discloses in col. 6, lines 34-50 that additives are for the purpose of stabilization of a slurry. This argument is respectfully found to be unpersuasive because Kaufmann teaches stabilizers can also aid in the prevention of decomposition(col. 6, lines 33-43). One of ordinary skill in the art would understand decomposition to involve the components of the slurry, including the liquid components. In addition, Hudson teaches the use of a slurry with the abrasive particles removed(col. 4, lines 40-49), in which commercially available slurry with the abrasives removed are also used, and because commercially available slurries would also be expected to contain stabilizers, Hudson would also include stabilizers in a composition in which the abrasives are removed, as there would be present those additives which were present in the solution such as stabilizers. Both of these references would therefore provide the motivation for the inclusion of the stabilizer in the composition. In addition, applicant has argued that Kaufmann does not teach a buffer nor an ionic buffer, but rather teaches an acid or a base or an amine for maintaining pH. This argument is respectfully traversed, as Kaufmann teaches acetic acid (col. 6, lines 4-7 and col. 2, lines 30-33). In addition, Kaufmann teaches that an organic acid is to be used as a buffer(col. 8, lines 30-40), so that in view of the disclosure of acetic acid in Kaufmann as a buffer, then the acetic acid taught by Kaufmann, it is implied, is a buffer. In addition, it is known in the art that acetic acid is a

buffer. Kaufmann further teaches oxalate, which is a polyprotic acid salt, as a component(col. 10, lines 1-10). Applicant has further argued that neither Hudson nor Hirabayashi teach a buffer. However, both Hudson and Hirabayashi are used in combination with Kaufmann, and are relied upon in combination with Kaufmann. With respect to the limitations of the newly added claims, Kaufmann teaches ammonium persulfate as the oxidizer(col. 4, lines 36-43) which is one of the recited oxidizing agents in claim 36, and Kaufmann teaches aminosulfuric acids as a passivating agent (col. 6, lines 1-9), which is interpreted as satisfying high molecular weight sulfur compounds recited in claim 41. MPEP 2144.04 points out that the elimination of an element of a composition is obvious when the function performed by the eliminated element is not required. In the use of a polishing pad which has a fixed abrasive, such as taught by Hudson, the particles are not required. For this reason, Hudson teaches the removal of the particles from a commercially available polishing slurry(col. 4, lines 35-50). Therefore, the composition taught by Kaufmann with the particles eliminated would have been obvious to one of ordinary skill in the art.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

Claims 16-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaufmann et al. (US 5,954,997) in view of Hudson(US 5,972,792) or in view of Hirabayashi, et al. (US 5,575,885).

The reasons are as given in paper No. 13 and as argued above.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Caridad M. Everhart whose telephone number is 703-308-3455. The examiner can normally be reached on Monday through Fridays 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Smith can be reached on 703-308-1323. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9318 for regular communications and 703-872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

11/23/03


CARIDAD EVERHART
PRIMARY EXAMINER